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PAGE 1/27 * RCVD AT 1/31/2006 2:25:07 PM [Eastern Standard Time] * SVR:USPTO-EFAXRF-6/27 * DNIS:2738300 * CSID:2095273315 * DURATION (mm:ss):12:20

Fax Cover Sheet



No. of Pages _____ (Including Cover page)

NOTES:

Attention To: Examiner
Cassandra Davis

Company: Art Unit 3611

Phone: _____

Fax 571-273-8300

From: EDGAR M. NASH

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NEW CENTRAL FAX NUMBER

Effective July 15, 2005

On July 15, 2005, the Central FAX Number will change to 571-273-8300. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number. To give customers time to adjust to the new Central FAX Number, faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005.

After September 15, 2005, the old number will no longer be in service and 571-273-8300 will be the only facsimile number recognized for "centralized delivery".

CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number.

Edgar M. Nash
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Modesto, CA 95356
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JAN 31 2006

FAX-dated response by Applicant Edgar M. Nash to Office Action dated (mailed) 11/03/2005 from Cassandra Davis, Art Unit 3611, regarding Application No. 09/878,456.

Dear Ms. Davis:

Due to its complexity my invention utilizes NEW COMBINATIONS of elements necessary to enable its previously unknown-to-the-art capabilities and facilitate the varied applications of this entirely *unique* device.

I note on the *Office Action Summary* form, in "Status" at top of page, you marked "2b - This action is nonfinal". Yet, on Page 6 of your *Detailed Action*, Paragraph 14, you state in bold face: **THIS ACTION IS MADE FINAL**. I'm confused.

Your Page 2, Pgh. 1 - I am providing the substitute Specification in accordance with the strict directions cited on Page 3 of your 3/11/2004 Office Communication (copy shown in the following inset), with added / retained material presented *in italics*.

Application/Control Number: 09/878,456
Art Unit: 3611

Page 3

4. Amendments to the Specification

Amendments to the specification are to be made by presenting a replacement paragraph, section or substitute specification marked up to show changes made relative to the immediate prior version. The changes should be shown by strikethrough (for deleted matter) or underlining (for added matter). An accompanying clean version is not required and should not be presented.

Your Page 2, Pgh. 2 My revised Amendment (to Specification) of May 6, 2003, complies with your requirements stated in your last sentence (top of Page 3).

To comply with directions in letter dated August 29, 2005, from Mr. John LeGuyader, Exec. Asst., Office of the Commissioner for Patents, I am providing a revised Claims, as shown on his mid-Page 4 ("*In order to comply with Rule 121 . . .*"), in which I also will comply with: your Page 3, Pghs. 3, 4, 6-10 I am including a copy of his letter, herewith.

Also, a complete Claims re-write is provided in the event your rejections cited in your Page 5, Pgh. 12 re ARNOLD are satisfied by my response re ARNOLD (3,680,238).

Your Page 5, Pghs 11 & 12: ARNOLD is claimed to be merely a single-purpose device with no variations in application other than his stated "Sign Display".

ARNOLD has 5 CLAIMS: (1) An Assembly of individually illuminated signs (2) An illuminated sign display (3) A combination outside entrance light and illuminated house number display (4) The combination entrance light and house number display (5) The combination entrance light and house display assembly

However, ARNOLD claims no method whatsoever for mounting/hanging/securing his device to any supporting structure, for there is not even a supporting screw or nail hole provided in any part of his sign display *assemblies*. The single exception in all configurations is the house-number sign which provides for its questionable support only by means of the base of a light bulb extending upward through the top of the housing being screwed into a light socket, which by definition must be in the ceiling of the entrance to a house. Entrance lighting for homes nearly always are wall-mounted, which would not accommodate ARNOLD. For safety reasons, ceiling lights at outside entrances of houses are intended to flood the entrances with light, which ARNOLD would utterly defeat when attached into the light socket in that location. *Further, a tall person's head may be injured badly when run into any part of ARNOLD's house number sign device.*

Reference: Your Page 5, Pgh. 12:

Note: A basic "Housing", "Box", "Frame", etc., is employed in ARNOLD, as also is claimed in RODRIGUEZ (4,831,755), PAYBERG (1,888,406), MIKOLAY (5,237,766), CAMPBELL (6,098,326), etc., etc., but all are used in combination with additional items. My invention *combines* its components into a unique and completely new-to-the-art entity, enabling achievement of multiple applications and display effects previously unknown.

ARNOLD's "housing 47" is described simply as: "*an elongated rectangular enclosure or box includes a back wall 50, a top wall 51, a bottom wall 52, and side walls 53 and 54.*" ARNOLD's rectangular enclosure or box does not claim any "tapered housing", and the very slight taper shown in his Fig. 9 is of no effect on his objective. My "taper" is vital to the successful operation of my invention.

For your convenience I am printing (from scanner) Arnold's entire Claims on a separate page attached hereto. Please forgive my markings on it.

Re "layers 16, 20 and 24": These "layers" are of highly technical special composition and single-purpose to support a sign display only: "*to reflect sunlight from the front of the display through the transparent areas . . . and to transmit artificial light from behind the sign display through the transparent areas at night*".

On the contrary, my invention accommodates readily-available basic commercial products.

The "*plurality of lights*" claimed by ARNOLD are only two in number, with no variations for uses other than the sign display. Both are inflexible and single-purpose:



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS

AUG 29 2005

Mr. Edgar M. Nash
2800 Braden Ave. #35
Modesto, CA 95356

Dear Mr. Nash:

Thank you for your letter to Under Secretary Dudas regarding your application 09/878,456. Your letter has been forwarded to me for consideration and response.

A member of our staff has thoroughly examined the prosecution history of your application and can see no evidence of abuse on the part of the patent examiner. Patent laws and statutes must be complied with in the preparation of papers included in the application process.

In an effort to assist you in the proper method of making amendments, see 37 CFR 1.121 reproduced below (with relevant sections highlighted):

§ 1.121 Manner of making amendments in applications.

(a) *Amendments in applications, other than reissue applications. Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.*

(b) *Specification. Amendments to the specification, other than the claims, computer listings (§ 1.96) and sequence listings (§ 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification, in the manner specified in this section.*

(1) *Amendment to delete, replace, or add a paragraph. Amendments to the specification, including amendment to a section heading or the title of the invention which are considered for amendment purposes to be an amendment of a paragraph, must be made by submitting:*

(i) *An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a paragraph with one or more replacement paragraphs, or add one or more paragraphs;*

(ii) *The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived;*

(iii) *The full text of any added paragraphs without any underlining; and*

(iv) *The text of a paragraph to be deleted must not be presented with strike-through or placed within double brackets. The instruction to delete may identify a paragraph by its paragraph number or include a few words from the beginning, and end, of the paragraph, if needed for paragraph identification purposes.*

(2) Amendment by replacement section. If the sections of the specification contain section headings as provided in § 1.77(b), § 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by submitting:

(i) A reference to the section heading along with an instruction, which unambiguously identifies the location, to delete that section of the specification and to replace such deleted section with a replacement section; and;

(ii) A replacement section with markings to show all changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

(3) Amendment by substitute specification. The specification, other than the claims, may also be amended by submitting:

(i) An instruction to replace the specification; and

(ii) A substitute specification in compliance with §§ 1.125(b) and (c).

(4) Reinstatement of previously deleted paragraph or section. A previously deleted paragraph or section may be reinstated only by a subsequent amendment adding the previously deleted paragraph or section.

(5) Presentation in subsequent amendment document. Once a paragraph or section is amended in a first amendment document, the paragraph or section shall not be represented in a subsequent amendment document unless it is amended again or a substitute specification is provided.

(c) Claims. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) Claim listing. All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1-5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) When claim text with markings is required. All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

(3) When claim text in clean version is required. The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with the status of "new" and presented in clean version, i.e., without any underlining.

(4) When claim text shall not be presented; canceling a claim.

(i) No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.

(5) Reinstatement of previously canceled claim. A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number. (d) Drawings: One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with § 1.84 and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the top margin, labeled "Replacement Sheet". Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. Any new sheet of drawings containing an additional figure must be labeled in the top margin as "New Sheet". All changes to the drawings shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

(1) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change to the drawings.

(2) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(e) Disclosure consistency. The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings. (f) No new matter. No amendment may introduce new matter into the disclosure of an application.

(g) Exception for examiner's amendments. Changes to the specification, including the claims, of an application made by the Office in an examiner's amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner's amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2), or (c) of this section is not required.

(h) Amendment sections. Each section of an amendment document (e.g., amendment to the claims, amendment to the specification, replacement drawings, and remarks) must begin on a separate sheet.

(i) Amendments in reissue applications. Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

(j) Amendments in reexamination proceedings. Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with § 1.530.

(k) Amendments in provisional applications. Amendments in provisional applications are not usually made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

The Notice of Non-Responsive Amendment which was mailed 7/5/05 was specifically sent in response to your claim amendments filed 4/13/04. Unfortunately, this amendment experienced an undue delay in being forwarded to the examiner. On behalf of the Office, I apologize for this unacceptable delay. Notwithstanding the delay, the failures to comply with Rule 121 (above) of the sort noted in the Notice of Non-Responsive Amendment could not have been dealt with earlier as the particular amendment was not of record in the application earlier.

It should be noted that, should this application mature to a U.S. Patent, it would be subject to a patent term adjustment under 35 U.S.C. 154 (b)(1)(A)(ii) to account for any delay within the USPTO greater than four months in responding to applicant's response.

Specifically addressing the amendment filed 4/13/04, the applicant has two versions each of claims 1 – 5 (one "cancelled" and one "new") as well as "new" claims 6-19.

In order to comply with Rule 121, once original claims 1-5 are cancelled, any new claims must start with "6" and be numbered sequentially. In this instance, the new claims are claims 6-24. So, the amendment should read as follows:

Claims 1-5 (cancelled)

Claim 6 (new) A portable artwork display means, comprising:
a lightbox means; and
an artwork containment frame means, and
an artwork display platen means.

Claim 7 (new) etc...

Once the format of the amendment is in compliance with Rule 121, a substantive consideration of the claims can be completed.

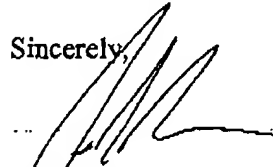
As you may have already found, prosecution of a patent application is complex. The USPTO cannot assist in the preparation of patent application papers. We strongly advise you to contact a registered patent attorney or agent. Although the USPTO cannot recommend any particular attorney or agent, we do maintain a roster of patent attorneys and agents registered to practice before the USPTO. Only registered attorneys and agents may help others to obtain patents. This link can be found at <http://www.uspto.gov/web/offices/dcom/olia/oed/roster/index.html>.

Free basic information on the patent and trademark system, forms, fees, products and services of the USPTO are available by calling the USPTO's toll-free line, 800-PTO-9199 or by calling 571-272-1000. An automated message system is available 7 days a week, 24 hours a day providing informational responses to frequently asked questions and the ability to order certain free

documents. Customer service representatives are available to answer questions, send free materials or connect you with offices of the USPTO from 8:30 a.m. – 5:00 p.m. ET, Monday-Friday excluding federal holidays. The customer service representatives can transfer your call to the Inventors Assistance Center or the Trademark Electronic Business Center for responses to practice and procedure questions. Much of this information is also available at the General Information section of the USPTO web site.

Again, I apologize for any undue delay you have experienced and I hope that this letter serves to assist you in re-drafting your amendment such that it complies with Rule 121. If you have any questions regarding the substance of this letter, please contact me at (571) 272-8800.

Sincerely,



John LeGuyader
Executive Assistant
Office of the Commissioner for Patents